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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/244,043	02/04/1999	HIRONORI KANNO	826.1535/JDH	3301

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EXAMINER

YANG, GRANT C

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 05/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/244,043

Applicant(s)

KANNO ET AL.

Examiner

Grant C Yang

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Final Rejection is responsive to the Letter of petition to restart filed 2/1/02, the dismissal filed 2/21/02 and Amendment A filed 3/28/02.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102

(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b).

Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 10, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Borman, U.S. Patent No. 5,890,172, filed Oct. 8, 1996, published Mar. 30, 1999.

Regarding independent claim 1, Borman discloses “obtaining information using address information”, such as a **URL**, as on column 5, line 60, defined on an “information network,” such as the **Internet**, as on column 5, line 51, and “outputting the thus-obtained information,” such as a **browser user I/O handles the task of translating files received from the Internet, e.g., HTML encoded files, to the**

presenter, as on column 6, lines 18-20. Furthermore, Borman discloses “informing the address information to the browser means according to a predetermined output sequence, and for instructing output of information corresponding to the thus-informed address information,” such as when a **start time button initiates the automatic and successive selection of every hot-link on the parsed list and the browser responsive thereto, displays for the user a file retrieved from the URL corresponding to each hot-link**, as on column 7, lines 11-15.

Regarding dependent claim 10, Borman discloses a “browser means” to obtain “information via a communication network using address information,” as a **browser outputs an URL**, which contains the address information, **across outgoing Internet line**, or communication network, and **communications with the Internet are received on incoming Internet line**, as on column 5, lines 60-61 and 63-64.

Regarding dependent claim 11, Borman discloses “a storage means for storing information to be outputted,” such as a **storage contains a storage segment in which the jumper stores parsed HTML files**, as on column 6, lines 2-3, and also the browser that “obtains information which is stored in the storage means using address information,” as the **browser handles Internet communications for the jumper**, as on column 6, lines 17-18, and the **browser user I/O uploads at the direction of jumper user I/O**, as on column 6, lines 23-24.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-7 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borman.

Regarding dependent claim 2, Borman discloses storing means, where a **jumper stores parsed HTML files**, as on column 6, line 3, as well as storing "address information," such as when **the parser extracts ... a plurality of URLs**, as on column 6, line 31. However, Borman does not expressly disclose correspondence relationship between an address and a sequence number. However, Borman discloses that a user can initiate a **successive selection of every hot-link on the parsed list**, and also allows the "control means" that "determines address information to be informed to the browser means," as Borman discloses the **browser responsive thereto, displays for the user a file retrieved from the URL**, as on column 7, lines 13-14. Clearly a successive selection of hot-links would need a sequence number stored with the addresses in order to know the correct succession of HTML files to load.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use sequence numbers corresponding with Borman's HTML slide-show, to display information. One of ordinary skill in the art would have been motivated to do this because in order to successively display files, a program would have needed to, at the minimum, internally store sequence numbers in order to know which the previous and next files to display would be.

Regarding dependent claim 3, a slide show system is disclosed above, and furthermore, Borman discloses an “operation means “ and “control means” for a “user to specify information to be outputted next,” where the address information is sent to the browser, as a **Next entry button selects the next hot-link on the list**, as on column 7, lines 9-10.

Regarding dependent claim 4, Borman discloses “information pieces before and after information currently being outputted,” as a user can select on a list the information before or after, or explicitly select on a list the elements before and after the current outputted information, by using a **Previous entry button**, a **Next entry button**, or a **Button bar**, as on column 9, lines 6-7, 9-10, and column 6, lines 63-64.

Regarding dependent claim 5, Borman discloses the “control means informs the ... address information to the browser means according to the output sequence,” as the **automatic and successive selection of every hot-link on the parsed list and the browser responsive thereto, displays for the user a file retrieved form the URL corresponding to each hot-link**, as in column 7, lines 12-15.

Regarding dependent claim 6, Borman discloses the slide show system means to have the browser use the address information to display the information at “prescribed time intervals,” as **the jumper directs the browser to access and display in the browser window ... files ... accessed by the browser in response to the jumper sending at timed intervals each of hot-links**, as on column 5, lines 36-40.

Regarding dependent claim 7, Borman discloses the time intervals and the sequence numbers, as explained above; however, Borman does not expressly disclose the time intervals changing according to the sequence numbers. However, it is clear

that the timed intervals are related to the sequence numbers as it is explained that the parsed list of URLs is displayed sequentially based on time intervals. Therefore, if the sequence or elements of the hot-list were to change, then clearly the time intervals would change with them.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have the time intervals change according to the sequence number. One of ordinary skill in the art would have been motivated to do this because in order to keep elements in a sequential list synchronized, the time intervals related to a sequence number must be consistent throughout execution of the display of the sequential list.

Regarding independent claim 12, Borman discloses a computer-readable storage medium which stores a program with "address information defined on an information network," as **the client for both the browser and the jumpers ... contains storage, computational hardware, operating system, and GUI** and is connected to the **Internet**, as on column 5, line 64 and lines 65-67 and column 6, line 1. Borman does not expressly disclose correspondence relationship between an address and a sequence number. However, Borman discloses that a user can initiate a **successive selection of every hot-link on the parsed list**, and also allows the "control means" that "determines address information to be informed to the browser means," as Borman discloses the **browser responsive thereto, displays for the user a file retrieved from the URL**, as on column 7, lines 13-14. Clearly a successive selection of hot-links would need a sequence number stored with the addresses in order to know the correct succession of HTML files to load.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use sequence numbers corresponding with Borman's HTML slide-show, to display information. One of ordinary skill in the art would have been motivated to do this because in order to successively display files, a program would have needed to, at the minimum, internally store sequence numbers in order to know which the previous and next files to display would be.

Regarding independent claim 13, Borman discloses a computer-readable storage medium referring to a correspondence relationship between address information and a sequence number, and is rejected similarly above. Furthermore, Borman discloses "obtaining information using address information" and "outputting the ... information," as **a browser ... displays for the user a file retrieved from the URL corresponding to each hot-link**, as on column 7, lines 13-15. Although Borman does not expressly disclose the sequence number, the use of the sequence number correlated to the address information is disclosed above and is similarly rejected.

Regarding independent claim 14, Borman discloses a slide show method directed to claim 12 above, and is similarly rejected, as "obtaining information using address information corresponding to a current sequence number" is the same as "obtaining address information corresponding to a sequence number" and "obtaining address information using the address information."

6. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borman as applied to claim 1 above, and further in view of Gorbet, U.S. Patent No. 6,072,480, filed Nov. 5, 1997, published Jun. 6, 2000, and Qureshi, U.S. Patent No. 6,084,582, filed Jul. 2, 1997, published Jul. 4, 2000.

Regarding dependent claim 8, Borman discloses the slide show system for obtaining address information for display in a predetermined output sequence; however, Borman does not disclose outputting music and narration with the output information. However, Gorbet discloses a mechanism for playing music soundtracks to accompany an electronic slide show, as on column 3, lines 66+ and column 4, line 1, and Qureshi discloses **a mechanism for recording audio, in particular audio narration, to accompany a set of slides stored on a computer storage medium**, as on column 3, lines 35-37.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine Gorbet's and Qureshi's different audio files to accompany Borman's slide show system. One of ordinary skill in the art would have been motivated to do this because clearly it was common at the time the invention was made to link audio, whether it is music or narration, with electronic slideshow systems. Therefore, in order to give a user the greatest flexibility in viewing slideshows, with information taken from addresses on a communication network, it would have been necessary to have the features of providing an audio accompaniment.

Regarding dependent claim 9, a slide show system with sound output is disclosed above; however, Borman does not expressly disclose the sound information being outputted according to the sequence number. However, Gorbet and Qureshi disclose the sound output that is associated with the slides, as explained above, and the sequence numbers are also related to the user-specified link addresses, also disclosed above.

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine Gorbet and Qureshi's sound files with Borman's sequence numbers and address links. One of ordinary skill in the art would have been motivated to do this because the address links and slides are associated to the sound files, and the address links are also associated with the sequence numbers. Therefore, in order to keep objects synchronized, they must be centered on a unique identifier, either a sequence number or the unique address link name.

Response to Arguments

7. Applicant's arguments filed 3/28/02 have been fully considered but they are not persuasive.

Regarding applicant's argument regarding the 102(e) rejection of claim 1. Applicant tries to argue that Borman does not disclose or suggest a "control unit" informing an address information to a browser unit according to a predetermined output sequence that is specified by a user. However, applicant then proceeds to contradict himself by stating that Borman discloses navigating sequentially through a list of hyperlinks at the direction of a user. Applicant fails to understand that hyperlinks are, in fact, web address information, as they usually are URL's that determine the location of a resource. Therefore, web addresses, hyperlinks, address information, URLs, are synonymous and notoriously well known in the art to be used interchangeably.

Regarding dependent claim 10, applicant states that the limitation of claim 10 has patentably distinguishing features; however, the applicant fails to provide any arguments whatsoever.

Regarding dependent claim 11, applicant states that Borman does not disclose “storing information to be outputted,” but again contradicts himself when he states that Borman discloses “storing an advertisement, a plurality of URLs and topic descriptors” as on Borman, col. 6, lines 30-32, and if one continues to read in Borman, the extracted information also sends this through an I/O protocol to **display to the user**, as on column 6, lines 35-36. Applicant insists that the information that is stored is a “web page” but then notes that this is disclosed in the specification and not limited in the claims. Therefore, claim 11 continues to be not allowable.

Regarding claims 12-14, applicant attempts to argue over the obviousness of the claims because the sequence is “predetermined by the user, and can be in any order;” however, Borman disclose that the **jumper user interface allows the user to see all the hot-links on a given level and to select a hot link in either a single jump or automatic jump mode**, as on column 6, lines 41-45, and in fact the applicant even agrees that Borman in (c) allows a user to choose the hyperlinks. Furthermore, applicant attempts to argue that the purpose is for a sequential slideshow that does not require manual advancement of the pages; however, this is not at all limited in the claims. The claims only state the association between addresses and their sequence numbers.

Regarding dependent claims 2-7, in particularly the address claim 2, Borman discloses that the plurality of sequence numbers associated with the address is not obvious stating that MPEP 706.02(j) requires that the prior art reference must teach or suggest all the claim limitations. However, applicant has failed to understand that “the rationale to modify or combine the prior art does not have to be expressly stated in the

prior art; the rationale may be expressly or impliedly contained in the prior art *or it may be reasoned from knowledge generally available to one of ordinary skill in the art*" as in MPEP 2144 (emphasis added). It is notoriously well known in the art when using sequential addresses and slideshows to, as stated in the previous office action for reasons of obviousness, at the minimum, internally store sequence numbers in order to know which the previous and next files to display would be. The examiner urges the applicant to please read the rejection for claim 2 again to understand the reasons for obviousness.

Regarding dependent claims 8-9, it has been disclosed and rejected earlier that "the sequence numbers are also related to the user-specified link addresses" and therefore in combination with Gorbet and Qureshi would have been obvious to a person having ordinary skill in the art to output sound information.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

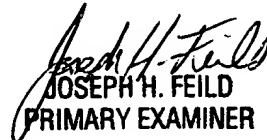
U.S. Patent No. 5809247

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Grant C Yang whose telephone number is 703-305-1828. The examiner can normally be reached on Mon-Fri (8:30am-6pm) every other Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on 703-308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

April 23, 2002


JOSEPH H. FEILD
PRIMARY EXAMINER